REMARKS

Claims 3, 5, 6, 8, 11-13, 15-35, 37-40, 42-52 and 54 are pending. The claims are amended as shown in the foregoing listing of claims, the claims marked "canceled" being canceled without prejudice. Claim 54 is new. Claims 22, 30 and 54 are independent claims.

Claim 22 as amended reads:

22.   A computer program product comprising a computer-readable storage medium containing a set of instructions for a general purpose computer having access to storage for computer files, such files comprising (a) executable application programs that generate various kinds of application type files and (b) application type files, the computer providing a computing environment via a user interface comprising an input responsive to user commands and a display capable of presenting the computer files in a general folder structure, the computer program product further comprising:
        code for storing and manipulating in response to user commands different kinds of application type files within said general folder structure;code for sending and receiving communication files from and to said general folder structure, wherein a communication file comprises one or more application type files;
        code for automatically associating the individual application type files comprising a communication with each other;
        code for saving any new file created with any application accessible to the user's computing environment into any activity folder within the general folder structure; and
         code for manipulating computer files within the activity folders , thereby allowing a user to group and organize subjectively related files of various application types within any of said activity folders, including grouping files which are associated with communications together with files which are not associated with communications within any of said activity folders.

Claim 30 as amended reads:

30.   A method for displaying and manipulating computer files within an information handling system wherein computer files are presented in a general folder structure including one or more activity folders, the method comprising:
        automatically identifying a particular communication comprising one or more files of one or more application types;

automatically storing each of the files of the particular communication as separate files in one and the same activity folder; and

automatically generating code for associating said separate files of the particular communication with each other;

thereby automatically allowing the separate files of the particular communication to be manipulated as independent files from said activity folder regardless of the application type.

New claim 54 reads:

54.   A method for displaying and manipulating computer files within an information handling system wherein computer files are presented in a general folder structure, the method comprising:

automatically identifying a communication including one or more files of one or more application file types, wherein said application file types include email messages and other file types;

automatically storing each of these files of the communication as separate files in the general folder structure;

automatically generating code for associating the separated files as related to a single communication,

thereby automatically allowing the separated but associated files of the communication to be manipulated as independent files within the general folder structure regardless of the application type.

Claims 25, 27 and 46 are amended to correct obvious typographic errors and not for reason of patentability. Claim 45 is amended for clarity in accordance with the Examiner's suggestion.

For convenience, the applicants of the present patent application will be referred to collectively herein as "Applicant."

Turning specifically to the Action of December 6, 2005, to which this is a response, Applicant appreciatively acknowledges the Examiner's recognition **in paragraphs 3 and 4** that this application discloses and claims patentable subject matter, at least as recited in claims 11, 12 and 26.

In paragraph 5, the Action rejects claim 45 as reciting a negative limitation "without a communication" that was not explicitly described in the specification. Claim 45 is amended to read as follows:

45.   The method of claim 30, further comprising:

identifying one or more files of one or more application types not associated with a communication; and

storing the identified files in the particular activity folder as separate files that can be manipulated from the activity folder regardless of application type.

Applicant submits that the claim 45 is amended to more expressly recite the disclosed concept that an activity folder may have stored it by the method of this invention **both** (a) files that are associated with a communication **and** (b) files that are not associated with a communication. This is not a negative limitation but rather an inclusion. Accordingly claim 45 meets the requirement of 35 U.S.C. § 112. Applicant appreciatively acknowledges the Examiner's suggestion **in paragraph 13** of the Action and submits that the present claim language is consistent with that suggestion.

In paragraph 6, the Action rejects claims 22-29 as reciting non-statutory subject matter. Claim 22 as amended recites the type of subject matter found patentable by the Court of Appeals for the Federal Circuit in In re Bauregard, 53 F.3d 1583 (1995). Claims 23-29 are dependent directly or indirectly from claim 22. Accordingly claims 22-29 meet the requirement of 35 U.S.C. § 101.

In paragraph 8, the Action rejects claims 3, 5, 6, 8, 13, 22-24 and 30-52 under 35 U.S.C. 102(e) as being anticipated by the Mellin et al. published PCT application WO 01/65336 ("Mellin PCT"). In the discussion on page 5 leading up to this paragraph, the Action states:

> The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Applicant respectfully points out that the foregoing statement is not relevant to the present rejection. Mellin PCT is not a U.S. patent but rather is a published PCT application. Applicant's attorney has searched for a corresponding U.S. patent and has found none. Moreover the Mellin PCT application was filed on February 28, 2001, after the effective date of AIPA. See front page Mellin PCT at field 22, International Filing Date.

Applicant submits that the prior art date of the reference is determined under 35 U.S.C. 102(3) after amendment by the AIPA (post-AIPA). Under that principle of law, the PCT reference would be a prior art reference for everything that it discloses, as of its actual filing date of February 28, 2001. In addition, the PCT reference would be a prior art reference as of its effective filing date based on its priority document, U.S. provisional patent application 60/185,719 ("Mellin Provisional"), **but only to the extent that the Mellin Provisional supports**

the disclosure of Mellin PCT. As the Examiner will see by comparing the disclosure of the Mellin Provisional with Mellin PCT, the two differ significantly. For the convenience of those reviewing the record of this case, Applicant provides a copy of the Mellin Provisional as an attachment to this Response of June 6, 2006.

The present application was filed July 19, 2001, claiming benefit under 35 U.S.C. § 119(e) to provisional U.S. patent application 60/219,294, filed July 19, 2000 (hereinafter sometimes identified for short as "Applicant's Provisional"). Applicant's Provisional was expressly incorporated by reference (see [0001] of the present application). Applicant is entitled to priority as of July 19, 2000, for all subject matter disclosed in Applicant's Provisional.

Accordingly, this case involves the following time sequence:

Feb. 29, 2000 - Mellin Provisional was filed
July 19, 2000 - Applicant's Provisional was filed
Feb. 28, 2001 - Mellin PCT was filed
July 19, 2001 - Applicant's present nonprovisional patent application was filed
Sept. 7, 2001 - Mellin PCT was published

Applicant acknowledges that under post-AIPA law, Mellon PCT is prior art as of its February 28, 2001 filing date. However, for each of Applicant's claims that is supported by Applicant's Provisional, **Mellin PCT is not prior art** unless the disclosure for which it is cited is also contained in the Mellin Provisional.

Applicant has reviewed its own provisional patent application 60/219,294 and has determined that the present claims are supported thereby. Thus the disclosure of Mellin PCT is not prior art to the present application unless the Mellin Provisional contains corresponding disclosure. Applicant has reviewed the Mellin Provisional and found that it lacks such disclosure. Accordingly the claims of the present application are patentable.

MPEP § 201.11 to § 201.15 relate to Applicant's benefit of priority, and make it clear that a reference with a February 28, 2001 filing date is **not** prior art **to any claims supported by Applicant's Provisional, filed July 19, 2000**. The following excerpts from Applicant's Provisional exemplify support for the recitations in the respective independent claims of the present application. They are not necessarily an exhaustive list of such support but are believed by Applicant to be sufficient to demonstrate it.

Support for Claim 22 in Applicant's Provisional

> The present invention increases efficient use of user time and effort by providing an information processing system and method by which a user groups and accesses different kinds of objects related to the same activity together in a general user-defined folder. Specifically, the present invention provides a user interface that allows a user to group and access different kinds of objects together in a general user-defined folder. The different kinds of objects that may be placed together in and accessed from the same folder include: application files and

documents; contacts such as address book entries, including email addresses and fax numbers; communication files such as emails and faxes; web browsing objects such as favorites or bookmarks; and web pages." (SUMMARY OF INVENTION, Features - Page 6, line 5-15)

"Further, the present invention provides a computer system having preloaded therein a software program that allows a user to place different objects that he or she defines as related to the same activity together within a user-defined folder of a general folder structure." (SUMMARY OF INVENTION, Features - Page 7, line 1-8)

"It is a feature of the present invention that application files, communication messages, email addresses and fax numbers of contacts, web bookmarks or favorites, and web sites can be stored together and accessed from the same folder of the activity-oriented interface. (SUMMARY OF INVENTION, Features - Page 7, line 11-14)

"It is also a feature of the present invention that communications containing attachments(s) are separated on arrival to the recipient into a text message file and attachment file(s), each attachment file bearing an indication of the sender and/or recipient. A further feature of the present invention identifies such attachments with a visible sticker note, which indicates the subject of the email message that the attachment accompanied. Text message files and attachments are also annotated with the specific date and time received or sent. In this way the user can relate and group within the general folder structure email messages with their attachments and yet still be able to process and perform operations on the attachments without having to so process the email messages." (SUMMARY OF INVENTION, Features - Page 7, line 15-24)

"It is also a feature of the present invention to provide visible icons by which the user can created and re-name user defined folders of a general folder structure into which the user may store together application files, communication messages, email address and fax numbers of contacts, web bookmarks, or favorites and websites..." (SUMMARY OF INVENTION, Features - Page 7, line 25 to Page 8, line 4)

"It is an important feature that the present invention couples the above features with a private email server. In so doing, a user, using the email functionality resident in a software program of the present invention, may send and receive emails directly within the user interface of the present invention upon connecting to an Internet Service Provider (ISP) of choice. Alternatively, a user may continue to send and receive email from a server other than the private server, which is connected to the user's ISP server." (SUMMARY OF INVENTION, Features - Page 8, line 5-11)

"Coupled to the compound features of email functionality and the direct access of different kinds of objects within the same user-defined folders..." (SUMMARY OF INVENTION, Features - Page 8, line 12-13)

"It is an advantage of the present invention that files and/or communication in various forms, such as e-mails and faxes, can be sent to the contacts listed in the same folder of the activity-oriented interface. It is a further advantage that all communications have a smart indication of sender for the received files, and a recipient for the sent files." (SUMMARY OF INVENTION, Advantages - Page 9, line 10-14)

"...The present invention solves the problem not solved by prior art by allowing the user to work separately on email messages and their attachments without leaving the same activity folder. Therefore, it is an important advantage of the present invention that a user may receive, amend, add to, move, and/or send an attachment within the same activity interface without having to access different folder structures first." (SUMMARY OF INVENTION, Advantages - Page 9, line 23 to Page 10 line 0)

"Activity - A user defined class of related files whereby a user lumps together different categories of information stored and accesses from different files into a conceptual whole and classifies the whole as a project, task, operation, etc. An activity is a user-defined folder that contains related files which were each not created from the same application programs." (DETAILED DESCRIPTION, **Definitions** - Page 12, line 13-17)

"Activity-oriented interface -A user interface, by which a user can create, manipulate, store and access various kinds of program application files from within the same folder. (DETAILED DESCRIPTION, **Definitions** - Page 12, line 18-20)

"General folder structure - The most comprehensive arrangement of hierarchically nested folders so that all folders are contained and organize within." (DETAILED DESCRIPTION, **Definitions** - Page 12, line 21-22)

"...Importantly, a user can save any new document created with any application accessible to the user's computing environment (either stored on a hard drive or network, or used directly from the internet) into any folder in the ARCHIVE 42. A user is not limited to saving files created with one application into one ARCHIVE folder. In practical terms, then, a user may create a new folder, naming it for a particular, activity, task, work session, project, etc., and then save it into that folder all files related to that activity, etc., regardless of which application they were created with. Thus, unlike software applications or operating systems in the prior art, the present invention actually permits a user to create a user-defined activity folder and to store different kinds of files - regardless of application type - into it, especially as shown in FIGS. 5 to 7.

(STORING DOCUMENTS FROM A VARIETY OF APPLICATIONS - Page 19, line 21 to Page 20, line 4)

Support for Claim 30 in Applicant's Provisional

"It is also a feature of the present invention that communications containing attachments(s) are separated on arrival to the recipient into a text message file and attachment file(s), each attachment file bearing an indication of the sender and/or recipient. A further feature of the present invention identifies such attachments with a visible sticker note, which indicates the subject of the email message that the attachment accompanied. Text message files and attachments are also annotated with the specific date and time received or sent. In this way the user can relate and group within the general folder structure email messages with their attachments and yet still be able to process and perform operations on the attachments without having to so process the email messages." (SUMMARY OF INVENTION, Features - Page 7, line 15-24)

"It is an advantage of the present invention that files and/or communication in various forms, such as e-mails and faxes, can be sent to the contacts listed in the same folder of the activity-oriented interface. It is a further advantage that all communications have a smart indication of sender for the received files, and a recipient for the sent files." (SUMMARY OF INVENTION, Advantages - Page 9, line 10-14)

"…The present invention solves the problem not solved by prior art by allowing the user to work separately on email messages and their attachments without leaving the same activity folder. Therefore, it is an important advantage of the present invention that a user may receive, amend, add to, move, and/or send an attachment within the same activity interface without having to access different folder structures of various applications first." (SUMMARY OF INVENTION, Advantages - Page 9, line 23 to Page 10 line 0)

"Activity - A user defined class of related files whereby a user lumps together different categories of information stored and accesses from different files into a conceptual whole and classifies the whole as a project, task, operation, etc. An activity is a user-defined folder that contains related files which were each not created from the same application programs." (DETAILED DESCRIPTION, **Definitions** - Page 12, line 13-17)

"Activity-oriented interface -A user interface, by which a user can create, manipulate, store and access various kinds of program application files from within the same folder. (DETAILED DESCRIPTION, **Definitions** - Page 12, line 18-20)

"General folder structure - The most comprehensive arrangement of hierarchically nested folders so that all folders are contained and organize within." (DETAILED DESCRIPTION, **Definitions** - Page 12, line 21-22)

"…The present invention separates e-mail messages from their attached files while storing these two kinds of files in the same folder, which is not done by the prior art. A user, therefore may process and access these two kinds of files from within the same folder." (STORING ELECTRONIC COMMUNICATIONS – Page 20, line 22-26)

"To reiterate, e-mail messages and their attachments are received by a user as two separate files, so that a user may store, process and access them as separate files within the same user-defined activity folder." (SENDING/RECEIVING ELECTRONIC COMMUNICATIONS - Page 22, line 3-6)

Support for Claim 54 in Applicant's Provisional

"It is also a feature of the present invention that communications containing attachments(s) are separated on arrival to the recipient into a text message file and attachment file(s), each attachment file bearing an indication of the sender and/or recipient. A further feature of the present invention identifies such attachments with a visible sticker note, which indicates the subject of the email message that the attachment accompanied. Text message files and attachments are also annotated with the specific date and time received or sent. In this way the user can relate and group within the general folder structure email messages with their attachments and yet still be able to process and perform operations on the attachments without having to so process the email messages." (SUMMARY OF INVENTION, Features - Page 7, line 15-24)

"General folder structure - The most comprehensive arrangement of hierarchically nested folders so that all folders are contained and organize within." (DETAILED DESCRIPTION, **Definitions** - Page 12, line 21-22)

Lack of Support in the Mellin Provisional

In contrast to the strong support in Applicant's Provisional, the Mellin Provisional fails to describe a situation in which all parts of the communication are stored in a single general folder structure. Not only does the Mellin Provisional fail to teach or suggest storage of a message in the same folder as its attachments, but it also fails to teach or suggest storage of those two objects within the same general folder system. The Mellin Provisional diagrams a program architecture where attachments and messages necessarily go to two entirely separate folder structures.

To be more specific, Applicant identifies the deficiencies in the Mellin Provisional in contrast to the strength of disclosure of Applicant's Provisional as to the following independent claims. Similar assertions support each of Applicant's pending claims.

Lack of Support in the Mellin Provisional for Claim 22

The Action of December 6, 2005 states:

"Referring to claim 22, Mellin [PCT] teaches a computer program product comprising code for receiving communications files, wherein a communication file comprises one or more application type files (receiving emails with attachments) (page 10, lines 1-14 and Figures 8 and 23); code for selecting an activity folder where an activity folder has at least one or more separate current user-defined activity folders (a plurality of user defined folders) (page 10, lines 1-14 and Figure 8);and code for associating the communications files comprising one or more application type files..."

Applicant responds that the Mellin Provisional does not describe a method or "code for associating the communications files comprising one or more application type files." Whereas Mellin PCT does appear to describe how "links" work to allow the user to associate and access the separated message and files originally comprising a communication through each other (Mellin PCT: pg 17, line 26-31/pg 18, lines 30-34/ and Figures 9 and 18), the Mellin Provisional does not describe any particular method by which attachments can be associated with emails or vice-versa.

Further, the Mellin Provisional explicitly describes and illustrates a mechanism by which the message of a communication is presented in one location known as the "Message Manager" and the files comprising the attachments of that communication are presented in a separate location known as the "Document Manager" (Mellin Provisional, pages 5-6, Figures 2 and 3, Appendix pages 5-6). No scenario is described in which all of the parts of an email communication, both message and file attachments, can be presented in the same folder structure. In addition, the technical specification and diagrams appear to exclude such a possibility, by illustrating (Mellin Provisional, Figures 2 and 3) and documenting an architecture in which "email attachments and other documents" are stored in an "Attachment Server/Repository" while "all data with the exception of email attachments" are stored in a "Database" (Mellin Provisional, Appendix pages 5-6). These figures illustrate that there is no general folder structure for both messages and attachments, but rather separate structures for each category.

Given the divided relationship of the Message Manager and Document Manager outlined in the Mellin Provisional, and the absence of a method described by which the message and attachments can be easily linked or otherwise associated with each from their separate lists/folders/locations, one cannot assume from the Mellin Provisional that an efficient and novel method of association is possible, much less presented.

Contrast this to the description in Applicant's Provisional quoted above with respect to Claim 22 at pages 15-18 of this Response.

While the Mellin Provisional does not discuss the subject, it does appear from the screenshots in the Provisional that attachments are annotated with sender/recipient and date/time information within the Document Manager (Figure 3). However, since the Attachments and

Messages which correspond to an individual communication are necessarily presented separately and in different lists/locations, it will be apparent to the skilled worker that as these lists become populated, it will become increasingly cumbersome for the user to visually match up and associate attachments in the Document Manager with their corresponding Messages in the Message Manager. More specifically, one can easily surmise that as the Message Manager is increasingly populated with a combination of messages that came both with and without attachments, and as the Document Manager is increasingly populated with both attachments as well as other files that did not arrive as attachments (those that were uploaded, for example), it will become impossible for the messages and attachments to match up in the kind of neat order temporarily shown to be present in Figure 3. Further, the Document Manager only lists those attachments in their latest modified form (Mellin Provisioinal, pg. 5, lines 15-23 - as groupware, when individuals modify a group attachment, the previous version is no longer displayed), and therefore in many cases it will be difficult for the user to easily match up the modified version of that file with the original email and attachments as they existed when originally delivered. As a result, associating attachments with their messages in a way that will allow the user to easily reconstruct the communication as a visual whole, and in its original form, may prove to difficult to impossible in many situations, as taught by the Mellin Provisional.

Applicant's Provisional, in contrast, describes a system where messages and attachments comprising a single communication are delivered to the same folder where they are listed side by side in the same folder with relevant annotations and sticker notes, making association easy in every instance. Applicant's Provisional teaches that the integrity of each communication (despite being split into individual files) be maintained, with all of its parts getting delivered and stored together in one and the same filing location.

The Mellin Provisional does not disclose or suggest any scenario in which ALL of the files comprising a communication, including BOTH a message and attachments, are allocated or presented within the same location or folders. As has been demonstrated above, Applicant's Provisional explicitly includes such a disclosure. In the Mellin Provisional, messages and attachments are presented in different locations, and therefore only those files of one or more application type which are NOT messages can be stored in the same set of folders.

Claim 30

The Action of December 6, 2005 states:

Referring to claim 30, Mellin [PCT] teaches a method comprising automatically identifying a communication comprising one or more files of one or application types (receiving emails with attachments) (page 10, lines 1-14 and Figures 8 and 23); automatically storing each of the files of the communication as separate files in a particular activity folder and thereby automatically allowing the separate files of the communication to be manipulated from the particular activity folder regardless of the application type (extracting attachments from emails and storing them as separate files so the attachments can be treated as separate entities) (page 17, lines 15-35 and further recited in the Abstract).

Applicant responds that the Mellin Provisional fails utterly to provide support with regard to the above on at least two separate counts:

1)   Mellin Provisional makes clear that the email message and attachments which comprise a single communication are not, and cannot, be presented in one and the same activity folder, but rather email messages and attachments necessarily go to separate locations.

It fails to describe any process of separating or extracting "embedded" attachments from the message of a single communication and then storing the separated parts as them is individual or "independent" files.

With regard to point 1, please refer to Applicant's above comments regarding Claim 22. The Mellin Provisional fails to support "storing each of the files of the communication as separate files in a particular folder and thereby manipulated from the particular activity folder regardless of application type" when "a particular folder" refers to a single folder or one and the same folder. As taught by the Mellin Provisional, all of the parts of a communication do not and cannot go to the same folder, and in fact that attachments go to one location and messages to another.

With regard to point 2, while Mellin PCT does in fact state that "a novel aspect of the invention is the separation of email attachments from the originating messages…the invention automatically extracts the embedded files from messages…It then treats each message as a separate entity…" (Mellin PCT: pg 17, lines 15-35) the Mellin Provisional offers no such description or explicit reference to any actual separation of the email and attachments into separate independent files. As noted above, statements in Mellin PCT that are not supported in Mellin Provisional are not prior art to the present application.

From a reading of Mellin Provisional, one of ordinary skill in the art at the time would not conclude that any scenario exists in which the parts of a communication are both separated into individual parts AND then delivered to the same folder. Such a scenario is mutually exclusive based on the description.

It should be noted that, Mellin's software is intended for group collaboration, and the advantage of separating attachments on the server in the form present in the Mellin Provisional is to allow users to have shared access to those attachments and allow those working documents to be modified by members of the group in a controlled environment (see Background Art description)…while avoiding "revisions being made in an uncontrolled manner, resent to recipients, revised again, etc. This process often results in a total loss of document control, in particular when the documents are shared over the Internet amongst multiple users" (Mellin Provisional, pg 2, line 10-17).

The purpose, therefore, is not to allow the user to store and manage email messages and attachments together with other files in a local general folder structure as is the case in the present invention. Unlike Applicant's disclosure, Mellin Provisional does not describe, or even leave possible, the ability of the user to manage email messages and attachments/files together in

the same general folder structure.

A disclosed advantage of the message and file management separation of the present invention is that it allows the user to instantly manipulate attachments as independent files without any intermediary steps. Those attachments can be immediately moved, copied, opened, or edited. Mellin Provisional, on the other hand, requires the intermediary step of download (Mellin Provisional, pg 6, lines 26-31, Figure 5) from the server.

Claim 54

Since Claim 54 is a method claim similar to Claim 30, the discussion above relating to Claim 30 is similarly appropriate and for brevity will not be repeated.

Paragraph 9 of the Action is moot as Claim 53 is canceled.

Paragraph 10 of the Action rejects Claims 17-21, 25, and 28-29 under 35 U.S.C. 103(a) as being unpatentable over Mellin PCT and Microsoft Outlook. Applicant has pointed out how the disclosures of Applicant's Provisional antedate Mellin PCT and thus remove it as prior art. Applicant has pointed out above how Mellin Provisional fails to support the disclosure attributed to Mellin PCT. The MS Outlook reference fails to support the missing subject matter. Thus, the rejection fails.

Paragraph 11 of the Action rejects Claims 15-16 and 27 under 35 U.S.C. 103(a) as being unpatentable over Mellin PCT and Venkatraman U.S. Patent 6,014,688 ("Venkatraman"). Applicant has pointed out how the disclosures of Applicant's Provisional antedate Mellin PCT and thus remove it as prior art. Applicant has pointed out above how Mellin Provisional fails to support the disclosure attributed to Mellin PCT. The Venkatraman reference fails to support the missing subject matter. Thus, the rejection fails.

CONCLUSION

Applicant submits that the foregoing is a complete response to the Action and that the claims as amended are allowable. Prompt notice of allowance is respectfully requested. If any questions remain, Applicant respectfully asks the Examiner to phone Applicant's undersigned attorney to seek to resolve them promptly.

Respectfully submitted: June 6, 2006

/GerryJayElman/
Gerry J. Elman, Reg. no. 24,404   Telephone: 610-892-9942
Elman Technology Law, P.C.   Fax: 925-226-4995
Customer no. 003775   email: gerry@elman.com